Ch'ng Kim Chye & Anor (t/a Lam Soon Huat) v SP Yam Huat Sdn Bhd

HIGH COURT (KUALA LUMPUR) — ORIGINATING SUMMONS NO WA-24IP-8–04 OF 2018
LIM CHONG FONG J
30 APRIL 2019

Trade Marks — Registration — Rectification — Rectification of the Register of Trade Marks — Aggrieved persons — Whether defendant's mark was an invented and fanciful word — Usage of mark in good faith — Trade Marks Act 1976 ss 10, 14(1)(b)–(1)(g) & 45

This was an application to rectify the Register of Trade Marks pursuant to s 45 of the Trade Marks Act 1976 ('the TMA'). The plaintiffs were involved in the business of trading in tobacco retail business under the partnership name of Lam Soon Huat whilst the defendant was a private limited company involved in the business of manufacturing and processing of tobacco products and the registered proprietor of trademark registration No 2011010139. The plaintiffs had since 2009 traded by distributing and selling Jawa tobacco using the 'plaintiffs' marks' albeit it not being a registered trademark. In 2009, the plaintiffs made an application to register the plaintiffs' mark but it was rejected by the Registrar of Trade Marks. The defendant had since 2008 traded its tobacco products bearing the word mark 'ORI' as used in the phrase 'Daun Rokok Kampung Ori'. The defendant made an application on 31 December 2010 to register its mark, but was rejected. As a result, the defendant sought the expertise of a trademark agent to make variations until it was finally registered on 19 October 2015. The defendant, on 22 January 2017 applied and obtained an ex parte court order pursuant to the Trade Descriptions Act 2011 by reason of an alleged infringement of the defendant's mark by several parties including the plaintiffs. The plaintiffs had since applied to set aside the aforesaid ex parte court order and order reliefs which was now pending before the Alor Setar High Court ('Alor Setar proceedings'). The plaintiffs on 16 April 2018 filed the present application. The plaintiffs contended that the defendant's mark in law was incapable of registration on the following grounds: (a) there was a missing distinctiveness in the defendant's mark which was incapable of distinguishing or differentiating their goods with that of the other traders; (b) they were in some way or other affected by the existence of the defendant's mark wherein their legal rights were inhibited and limited; (c) the defendant's mark failed to relate or connect with the source of its goods in breach of s 3 of the TMA; and (d) the defendant's mark failed to meet with the requirements of ss 3 and 10(1) of the TMA in that it did not meet the requirements of being invented words and/or words having no direct reference to the character or quality of the goods

being tobacco products and/or that it was distinctive. The defendants contended the following: (i) the defendant's mark was an invented word/image and was non descriptive . It was a fancy word/mark which was registrable after having been carefully deliberated by the Registrar of Trade Marks over four years; (ii) public consumers in the market knew and recognised the defendant's products by the word 'Ori' because the defendant had been labelling themselves as 'Daun Rokok Kampung Ori' since 2008; and (iii) that the plaintiffs took contradictory stances by attempting to be declared as the common law proprietor of the plaintiff's mark containing the word 'Ori' in the Alor Setar proceedings but challenged the incapability of registration of the word 'Ori' here.

Held, dismissing the application with costs of RM25,000 subject to 4% allocator:

(1) The plaintiffs were aggrieved persons because they were genuine business competitors of the defendant in tobacco trading and were operating within the same geographical vicinity of Northern West Malaysia. The parties also appeared to have commenced their businesses around the same time in the late 2000s and they used marks/logos that carried the words 'Ori' in trading their tobacco products (see para 20).

(2) The defendant's mark was an invented and fanciful word. 'Ori' was neither related nor connected with the word 'original'. It followed that the defendant's mark could not therefore be construed as a representation of the quality of the defendant's tobacco being original and hence not blended or fake whether pertaining to its flavour, aroma, etc (see paras 27–28).

(3) The defendant had at all material times intended to use the defendant's mark in good faith to distinguish its tobacco products from those marketed by other traders and potentially these other traders were unlikely without improper motive to utilise a similar mark. Its unique features capable of distinguishing the tobacco marketed by the defendant versus that of other traders. The defendant's mark was innate; hence an inherently distinctive mark in law and this was also per se sufficient to dismiss the application (see para 31).

[Bahasa Malaysia summary

Ini merupakan permohonan untuk membetulkan daftar cap dagangan selaras dengan s 45 Akta Cap Dagangan 1976 ('ACD'). Plaintif terlibat dalam urusan perdagangan perniagaan jualan tembakau dibawah satu nama perkongisan Lam Soon Huat, manakala defendan merupakan satu syarikat sendirian berhad yang terlibat dalam urusan membuat dan memproses produk tembakau dan merupakan pemilik berdaftar cap dagangan nombor pendaftaran 2011010139. Plaintif sejak 2009 berniaga dam menjual tembakau Jawa

menggunakan cap plaintiff walaupun ianya bukan cap dagangan berdaftar. Pada tahun 2009, plaintif membuat permohonan untuk mendaftarkan cap plaintif namun ianya ditolak oleh pendaftar cap dagangan. Defendan telah sejak tahun 2008 mendagangkan produk tembakaunya yang membawa cap perkataan 'ORI' seperti yang digunakan dalam frasa 'Daun Rokok Kampung Ori'. Defendan membuat permohonan pada 31 Disember 2010 untuk mendaftarkan capnya, namun ianya ditolak. Oleh itu, defendan mendapatkan kepakaran agen cap dagangan untuk membuat penggubahan kepadanya sehingga ianya didaftarkan pada 19 Oktober 2015. Defendan pada 22 Januari 2017 memohon dan mendapatkan perintah mahkamah ex parte selaras dengan Akta Perihal Dagangan 2011 atas sebab satu pelanggaran yang kononnya berlaku oleh cap defendan oleh beberapa pihak termasuk plaintif. Plaintif telah kemudiannya memohon untuk mengetepikan perintah mahkamah ex parte tersebut dan beberapa relif lain yang kini menantikan keputusan Mahkamah Tinggi Alor Setar ('prosiding Alor Setar'). Plaintif pada 16 April 2018 memfailkan permohonan ini. Plaintif menghujahkan bahawa cap defendan disisi undang-undang tidak boleh didaftarkan atas alasan berikut: (a) tiada ciri-ciri tersendiri dalam cap defendan yang tidak boleh membezakan barangan mereka dengan pedagang lain; (b) mereka dipengaruhi dengan kewujudan cap defendan yang mana hak disisi undang-undang mereka disekat dan dihadkan; (c) cap defendan galgal untuk mengaitkan atau menghubungkan dengan sumber barang-barangnya dan melanggar s 3 ACD; dan (d) cap defendan gagal untuk memenuhi keperluan ss 3 dan 10(1) ACD yang mana ianya tidak memenuhi keperluan yang merupakan perkataan yang direka dan/atau perkataan yang tiada rujukan khusus kepada karakter atau kualiti barangan yang merupakan produk tembakau dan atau ianya mempunyai ciri-ciri tersendiri. Defendan menghujahkan seperti berikut: (i) cap defendan adalah perkataan yang direka/imej dan adalah tidak deskriptif. Ianya merupakan perkataan yang dibayangkan/tanda yang boleh didaftar setelah dipertimbangkan secara teliti oleh pendaftar cap dagangan selama tempoh empat tahun; (ii) pengguna awam dalam pasaran mengetahui dan mengenali produk defendan melalui perkataan 'Ori' kerana defendan telah melabelkan diri mereka sebagai 'Daun Rokok Kampung Ori' sejak 2008; (iii) plaintif membuat perdirian yang bercanggah dengan cuba untuk mengisytiharkan sebagai pemilik *common law* cap plaintif yang mengandungi perkataan 'Ori' dalam prosiding Alor Seta tetapi mencabar keboleh pendaftaran perkataan 'Ori' disini.

Diputuskan, mengetepikan permohonan dengan kos RM25,000 tertakluk kepada 4% alokatur:

(1) Plaintif merupakan orang yang terkilan kerana mereka merupakan saingan perniagaan defendan dalam perdagangan tembakau dan beroperasi dalam kawasan geografi di utara Semenangjung Malaysia. Pihak-pihak juga didapati telah memulakan perniagaan mereka pada

A waktu tama iaitu lewat 2000s dan menggunakan cap/logo yang membawa perkataan 'Ori' dalam memperdagangkan produk tembakau mereka (lihat perenggan 20).

(2) Cap defendan merupakan perkataan yang direka dan khayalan. 'Ori' tidak berkaitan dengan perkataan 'original'. Oleh itu cap defendan tidak boleh dianggap sebagai representasi kualiti tembakau defendan sebagai asli dan tidak di campur atau palsu sama ada berkenaan dengan rasa, aroma, dan lain-lain (lihat perenggan 27–28).

(3) Defendan pada semua masa yang material perniat untuk menggunakan cap defendan dengan niat baik untuk membezakan produk tembakaunya dengan yang dipasarkan oleh peniaga lain dan kebarangkalian peniaga lain ini tidak berkebarangkalian tanpa niat salah untuk menggunakan cap yang hampir serupa. Ciri-ciri uniknya membolehkan ianya dibezakan dengan tembakau yang dipasarkan oleh defendan berbanding dengan peniaga lain. Cap defendan adalah 'innate', oleh itu adalah satu cap yang tersendiri di sisi undang-undang dan ini adalah memadai untuk mengetepikan permohonan (lihat perenggan 31).]

Notes

For cases on rectification, see 12(2) *Mallal's Digest* (5th Ed, 2017 Reissue) paras 3057–3060.

Cases referred to

Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading) [2006] 6 MLJ 445; [2006] 3 CLJ 393, CA (distd)

Brock (H N) & Co's Application, Orlwoola, Re sub nom Re Trade Marks Act 1905 (1909) 26 RPC 68 (distd)

Electrix Ltd's Application for Trade Marks [1959] RPC 283, HL (distd)

Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M) [2009] 9 MLJ 101; [2010] 3 CLJ 837, HC (refd)

Joseph Crosfield & Sons Ltd, Re (Perfection Trade Mark) (1909) 26 RPC 837, Ch D (refd)

Lim Teck Lee (Malaysia) Sdn Bhd v Longcane Industries Sdn Bhd [2017] MLJU 620, HC (refd)

Liwayway Marketing Corp v Oishi Group Public Co Ltd [2017] 4 MLJ 141, FC (refd)

Lockheed Martin Corp v Raytheon Co [2010] 7 MLJ 624; [2010] 4 CLJ 95, HC (refd)

Ng Chye Mong Pte Ltd v PP [1988] 2 MLJ 150 (refd)

Oishi Group Public Co Ltd v Liwayway Marketing Corp [2015] 9 MLJ 538, HC (refd)

Powell's Trade Mark (1894) 11 RPC 4, HL (refd)

Powell's Trade Mark, Re [1893] 2 Ch 388, CA (refd)

Ripley & Son's Trade Mark, Re (1898) 15 RPC 151, CA (distd)

Titan (M) Sdn Bhd v The Registrar of Trade Marks [2009] 7 CLJ 338, HC (distd)
Walton International Ltd v Yong Teng Hing (b/s Hong Kong Trading Co) [2011] 5 MLJ 397; [2010] 8 CLJ 802, CA (refd)
Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors [2008] 7 MLJ 803, HC (refd)
Van Duzer's Trade-Mark In Re Leaf, Sons, & Co's Trade-Mark, In Re (1887) 34 Ch D 623; (1887) 56 LJ Ch 377, CA (refd)
'Soflens' Trade Mark [1976] RPC 694 (distd)

Legislation referred to

Trade Descriptions Act 2011
Trade Marks Act 1976 ss 3, 10, 10(1), (1)(c), (1)(d), 14, 14(1)(b), (1)(c), (1)(d), (1)(e), (1)(f), (1)(g), 45

Khaw Han Meng (Tan How Siang with him) (Peter Huang & Richard) for the plaintiffs.
Ho Sze Yee (CY Ten & Co) for the defendant.

Lim Chong Fong J:

INTRODUCTION

[1] This is an application to rectify the Register of Trade Marks pursuant to s 45 of the Trade Marks Act 1976.

[2] The plaintiffs are individuals and brothers involved in the business of trading in tobacco retail business under the partnership name of Lam Soon Huat.

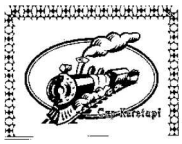
[3] The defendant is a private limited company involved in the business of manufacturing and processing of tobacco products and the registered proprietor of trademark registration No 2011010139 in Class 34 as follows:

('the defendant's mark').

A BACKGROUND FACTS

[4] The plaintiffs have since 2009 traded by distributing and selling Jawa tobacco using the following marks albeit it is not a registered trademark:

B



C

D

E

F ('the plaintiffs' mark').

[5] The plaintiffs had in 2009 made an application to register the plaintiffs' mark but it was rejected by the Registrar of Trade Marks.

G [6] The defendant has since 2008 traded in its tobacco products bearing the word mark 'ORI' as used in the phrase 'Daun Rokok Kampung Ori'. Accordingly, the defendant made an application on 31 December 2010 to register its mark. It was however rejected by the Registrar of Trade Marks. As the result, the defendant sought the expertise of a trademark agent to make H variations to the mark and made another application on 2 June 2011 to register its varied mark. It was again rejected by the Registrar of Trade Marks for non-compliance with the provisions in s 10 of the Trade Marks Act 1976 ('the TMA'). After further adjustment by its trademark agent, the defendant's mark was finally registered on 19 October 2015.

I

[7] Consequently, the defendant on 22 January 2017 applied and obtained an ex parte court order pursuant to the Trade Descriptions Act 2011 from the Alor Setar High Court by reason of alleged infringement of the defendant's mark by several parties including the plaintiffs. The plaintiffs have since

applied to set aside the aforesaid ex parte court order together with other reliefs and that application is presently pending in the Alor Setar High Court ('Alor Setar proceedings').

[8] As the result, the plaintiffs on 16 April 2018 filed this originating summons ('OS') for the following reliefs:

(i) Satu deklarasi bahawa Pendaftaran Cap Dagangan No. 2011010139 dengan representasi

dalam Kelas 34 yang didaftarkan atas nama Defendan adalah cap dagangan yang telah didaftarkan tanpa kausa munasabah dan/atau suatu cap dagangan yang tidak sah dan/atau secara salah dibenarkan terus berada dalam Buku Daftar Cap Dagangan Malaysia;

(ii) Bahawa Pendaftaran Cap Dagangan No. 2011010139 dengan representasi

dalam Kelas 34 yang didaftarkan dalam nama Defendan dibatalkan ('expunged') dan dipadamkan ('removed') dari Buku Daftar Cap Dagangan menurut Seksyen-seksyen 3, 10, 25, dan 45 Akta Cap Dagangan 1976;

(iii) Bahawa sesalinan Perintah termeterai untuk meminda Buku Daftar Cap Dagangan disampaikan kepada Pendaftar Cap Dagangan menurut Peraturan 75, Peraturan-Peraturan Cap Dagangan 1997 dan bahawa Pendaftar Cap Dagangan mengambil langkah-langkah yang perlu untuk membatalkan dan memadamkan Cap Dagangan No. 2011010139 dengan representasi

dalam Kelas 34 dari Buku Daftar Cap Dagangan serta mengiklankan pembatalan dan pemadaman Cap Dagangan tersebut dalam Warta Kerajaan;

(iv) Bahawa Defendan membayar semua kos untuk permohonan ini termasuk kos simpangan untuk meminda Buku Daftar Cap Dagangan di pejabat Pendaftar Cap Dagangan di Malaysia;

(v) Relif selanjutnya ataupun relif-relif lain yang dianggap sesuai dan berpatutan oleh Mahkamah yang Mulia ini.

[9] The affidavits that were filed in connection with this OS are as follows:

(a) the plaintiffs' affidavit in support affirmed by Ch'ng Kim Chye dated 13 April 2018;

(b) the defendant's affidavit in reply affirmed by Yeap Chuan Chong dated 14 May 2018;

A (c) the plaintiffs' affidavit in reply affirmed by Ch'ng Kim Chye dated 14 June 2018;

(d) the defendant's affidavit in reply (II) affirmed by Yeap Chuan Chong dated 1 August 2018;

B (e) the plaintiffs' affidavit in reply (II) affirmed by Ch'ng Kim Chye dated 17 August 2018; and

(f) the defendant's further affidavit affirmed by Yeap Chuan Chong dated 4 September 2018.

C

[10] The OS came before me and after having read the written submissions and heard oral arguments of counsel on 19 March 2019, I reserved my decision for further deliberation on the arguments advanced by counsel.

D **[11]** Now having duly done so, I furnish below my decision together with the supporting grounds.

CONTENTIONS AND FINDINGS

E **[12]** Since there is the connected Alor Setar proceedings that is still ongoing, the parties particularly the plaintiffs have in a nutshell confined their contentions here to the defendant's mark which is in law incapable of registration.

F **[13]** According to the plaintiffs, they instituted this OS to seek justice for themselves as well as other traders and the general public who are accustomed in purchasing tobacco products and articles so that their rights and other traders' right to use a common word 'original' is not hampered or restricted when their goods are described as original goods. It is also to augur the interest G of the public so that they are not subjected to any misleading apprehension as to where the goods originated. There is in this sense a missing distinctiveness in the defendant's mark which is incapable of distinguishing or differentiating their goods with that of the other traders.

H **[14]** In furtherance of the plaintiffs' case, they claimed to be aggrieved persons as propounded in the case of *Oishi Group Public Co Ltd v Liwayway Marketing Corp* [2015] 9 MLJ 538. They say that they are in some way or other affected by the existence of the defendant's mark wherein their legal rights I are inhibited and limited relying on *Powell's Trade Mark* (1894) 11 RPC 4 wherein Lord Watson held as follows:

> Whatever benefit is gained by registration must entail a corresponding disadvantage upon a trader who might possibly have had occasion to use the mark in the course of his business.

[15] The substantive objections of the plaintiffs are firstly that the defendant's mark failed to relate or connect with the source of its goods in breach of s 3 of the Trade Marks Act 1976 ('the TMA') following *Ng Chye Mong Pte Ltd v Public Prosecutor* [1988] 2 MLJ 150. The plaintiffs secondly pointed out that the defendant's mark failed to meet with the requirements of ss 3 and 10(1) of the TMA in that it did not meet the requirements of being invented words and/or words having no direct reference to the character or quality of the goods being tobacco products and/or that it is distinctive. Reliance is made on the case of *Lockheed Martin Corp v Raytheon Co* [2010] 7 MLJ 624; [2010] 4 CLJ 95.

[16] On the other side, the defendant contended in rebuttal that the defendant's mark is an invented word/image and is non descriptive. It is a fancy word/mark which is registrable after having been carefully deliberated by the Registrar of Trade Marks over four years. According to the defendant, the defendant's Mark has to be seen/read as a logo in its entirety. It is neither equal to 'ORIGNAL' or 'Original'. It was accepted by the Registrar of Trade Marks as an invented word/image not amounting to any inference of or reference to the word 'Original' generally. In addition, the defendant contended that public consumers in the market know and recognise the defendant's products by the word 'Ori' because the defendant has been labelling themselves as 'Daun Rokok Kampung Ori' since 2008. It has been consistently used as such. Furthermore according to the defendant, the plaintiffs however took contradictory stances by attempting to be declared as the common law proprietor of the plaintiff's mark containing the word 'Ori' in the Alor Setar Proceedings but challenged the incapability of registration of the word 'Ori' here. The defendant similarly relied on the case of *Lockheed Martin Corporation v Raytheon Company*.

[17] The relevant statutory provisions for the purpose of this OS are ss 3, 10, 14 and 45 of the TMA that read:

> 3 Interpretation
>
> (1) In this Act, unless the context otherwise requires —
>
> ...
>
> 'word' includes an abbreviation of a word.
>
> 10 Registrable trade marks
>
> (1) In order for a trade mark (other than a certification trade mark) to be registrable, it shall contain or consist of at least one of the following particulars:
>
> (a) the name of an individual, company or firm represented in a special or particular manner;

(b) the signature of the applicant for registration or of some predecessor in his business;

(c) an invented word or words;

(d) a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or

(e) any other distinctive mark.

(2) A name, signature or word which is not described in paragraph (1)(a), (b), (c) or (d) is not registrable unless it is by evidence shown to be distinctive.

(2A) For the purposes of this section, 'distinctive', in relation to the trade mark registered or proposed to be registered in respect of goods or services, means the trade mark must be capable of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered, subject to conditions, amendments, modifications or limitations, in relation to use within the extent of the registration.

(2B) In determining whether a trade mark is capable of distinguishing as aforesaid, regard may be had to the extent to which —

(a) the trade mark is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in the Register in respect of any goods or services.

14 Prohibition on registration

(1) A mark or part of a mark shall not be registered as a trade mark —

(a) if the use of which is likely to deceive or cause confusion to the public or would be contrary to law;

(b) if it contains or comprises any scandalous or offensive matter or would otherwise not be entitled to protection by any court of law;

(c) if it contains a matter which in the opinion of the Registrar is or might be prejudicial to the interest or security of the nation;

(d) if it is identical with or so nearly resembles a mark which is well-known in Malaysia for the same goods or services of another proprietor;

(e) if it is well-known and registered in Malaysia for goods or services not the same as to those in respect of which registration is applied for:

Provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the

proprietor of the well-known mark, and the interests of the proprietor of the well-known mark are likely to be damaged by such use;

(f) if it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in Malaysia is of such a nature as to mislead the public as to the true place of origin of the goods; or

(g) if it is a mark for wines which contains or consists of a geographical indication identifying wines, or is a mark for spirits which contains or consists of a geographical indication identifying spirits, not originating in the place indicated by the geographical indication in question.

(2) Article 6bis of the Paris Convention and Article 16 of the TRIPS Agreement shall apply for the purpose of determining whether a trade mark is a well-known trade mark.

45 Rectification of the Register

(1) Subject to the provisions of this Act —

(a) the Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry or by any entry made in the Register without sufficient cause or by any entry wrongfully remaining in the Register, or by any error or defect in any entry in the Register, make such order for making, expunging or varying such entry as if thinks fit;

(b) the Court may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the Register;

(c) in case of fraud in the registration, assignment or transmission of a registered trade mark or if in his opinion it is in the public interest to do so, the Registrar may himself apply to the Court under this section;

(d) an order of the Court rectifying the Register shall direct that notice of the rectification be served on the Registrar in the prescribed manner and the Registrar shall upon receipt of the notice rectify the Register accordingly.

[18] I noticed in the Court of Appeal case of *Walton International Ltd v Yong Teng Hing (b/s Hong Kong Trading Co)* [2011] 5 MLJ 397; [2010] 8 CLJ 802 which was followed in *Lim Teck Lee (Malaysia) Sdn Bhd v Longcane Industries Sdn Bhd* [2017] MLJU 620 that the failure of an aggrieved party in making a prior challenge on the act of the Registrar of Trade Marks including an appeal against the dismissal of a notice of opposition of a trademark is not fatal to the party from seeking to later challenge the trademark in the High Court including to rectify the register as in the OS here.

[19] In respect of the threshold statutory requirement of the plaintiffs being aggrieved persons, the law has been succinctly set out by Balia Yusof FCJ in the Federal Court case of *Liwayway Marketing Corp v Oishi Group Public Co Ltd* [2017] 4 MLJ 141 as follows:

> [10] In dealing with the issue of aggrieveness, learned counsel for Liwayway submitted that in order to satisfy the test as to whether the applicant falls within the definition of 'a person aggrieved' in the said provision, Oishi Group must first show that it has either used before a mark that is identical with or similar to the registered mark sought to be expunged or at the very least had a genuine intention to use the mark in the near future.
>
> [11] Our courts are replete with decisions on this issue. We will start with the case of *McLaren International Ltd v Lim Yat Meen* [2009] 5 MLJ 741; [2009] 4 CLJ 749 wherein this court upon considering the judgment of Chan Sek Keong JC in *Re Arnold D Palmer In The Matter of Trade Mark Registration No 63249* [1987] 2 MLJ 681 and the authorities cited therein, agreed that:
>
> > A person aggrieved is a person who has used his mark as a trademark — or who has genuine and present intention to use his mark as a trademark — in the course of a trade which is the same or similar to trade of owner of the registered trademark that the person wants to have removed from the register.
>
> [12] *McLaren International* was referred to and reaffirmed in the case of *LB (Lian Bee) Confectionery Sdn Bhd v QAF Ltd* [2012] 4 MLJ 20; [2012] 3 CLJ 661. At p 28 (MLJ); p 671 (CLJ) of the report, this court had explained the following:
>
> > A 'person aggrieved' under s 46(1) of the TMA need not be a person with any specific right. A 'person aggrieved' in this context may include someone with simply a bona fide intention to use a trademark that is registered but which has not been used by the registered proprietor or any registered user for a continuous period of not less than three years up to one month before the date of an application under s 46(1)(b) of the TMA to expunge. On this point in the case of *Mc Laren International Ltd v Lim Yat Meen* [2009] 5 MLJ 741; [2009] 4 CLJ 749, Abdul Aziz Mohamad FCJ in delivering the judgment of this court had this to say:
> >
> > > [21] *Re Arnold D Palmer* is an authority (out of several) that is heavily relied on by the respondent to deny that the appellants are a person aggrieved. In that case, the applicant sought the removal from the register of a trademark on the ground of non-user. On whether the applicant was a person aggrieved, Chan Sek Keong JC, after considering the speeches of Lord Herschell and Lord Watson in the House of Lords in *Powell's Trade Mark* [1894] 11 RPC 4; [1984] AC 8, and the manner in which subsequent judges reacted to the opinions of the said Law Lords in *Lever Bros Port Sunlight Ltd v Sunniwite Products Ltd* [1949] 66 RPC 84, *Consort Trade Mark* [1980] RPC 160, and *Wells Fargo Trade Mark* [1977] RPC 503 concluded as follows:
> > >
> > > > On the basis of these decisions, it is plain that the applicant will fail in this appeal unless he can show that he has used his trademark in the course of a trade which is the same as or similar to that of the respondents or that he

> has a genuine and present intention to use the mark as a trademark. But the evidence shows none of these things, as the Registrar has found ...
>
> [22] We understand that passage as lying down the principle that a person aggrieved is a person who has used his mark as a trademark — or who has a genuine and present intention to use his mark as a trademark — in the course of a trade which is the same as or similar to the trade of the owner of the registered trademark that the person wants to have removed from the register.
>
> Thus a 'person aggrieved' may have no rights at all but merely a genuine intention to use a trademark that is registered but which has not been used by the registered proprietor.

[13] More recently, in the case of *Mesuma Sports Sdn Bhd v Majlis Sukan Negara Malaysia (Pendaftar Cap Dagangan Malaysia, interested party)* [2015] 6 MLJ 465, Azahar Mohamad FCJ delivering the judgment of this court reiterated:

> A person aggrieved is a person who has used his mark as a trademark or who has genuine and present intention to use his mark as a trademark in the course of a trade which is the same as or similar to the registered trademark that the person wants to have removed from the register. The person must be someone who has some element of legal interest, right or legitimate expectation in its own mark which is being substantially affected by the presence of the registered trademark. The interest and right must be legal or lawful.

[20] Notwithstanding that this requisite statutory threshold requirement has not been disputed by the defendant, I am satisfied from the evidence adduced before me that the plaintiffs are aggrieved persons because they are genuine business competitors of the defendant in tobacco trading and are operating within the same geographical vicinity of Northern West Malaysia. The parties also appeared to have commenced their businesses around the same time in the late 2000s and they used marks/logos that carried the words 'Ori' in trading their tobacco products.

[21] Next and pertinently on the registrability of the defendant's mark, the defendant strenuously contended that it is an invented and fanciful word which is also inherently distinctive. The defendant maintained that the defendant's mark has no connection with the word 'Original' whatsoever.

[22] The thrust of the plaintiffs' complaint in this OS is that the defendant's Mark glaringly carries the word 'Ori' which is the abbreviation of the word 'Original'. According to the plaintiffs, the normal usage of the word 'Original' cannot be a trademark which would not indicate where the goods originated from as opposed to that of other traders. It is instead a common or generic word used descriptively as information to consumers which is non-registrable following the Court of Appeal case of *Bata Ltd v Sim Ah Ba @ Sim Teng Khor & Ors (trading as Kheng Aik Trading)* [2006] 6 MLJ 445; [2006] 3 CLJ 393.

The plaintiffs stressed that the information conveyed to customers by the defendant's mark which featured the word 'Original' and abbreviated prominently as 'Ori' is a representation of the quality of its tobacco. This is forbidden by s 10(1)(d) of the TMA. Finally the plaintiffs contended that the defendant's mark is also neither distinctive nor capable of distinguishing the defendant's goods from the goods of other traders.

[23] Generally, it was held by Ramly Ali J (now FCJ) in *Yong Sze Fan & Anor v Sharifah binti Mohd Tamin & Ors* [2008] 7 MLJ 803 as follows:

> From the wordings of s 10(1) it is clear that only one condition needs to be satisfied for the mark to be considered to be registrable. There is no necessity for the proprietor of the mark to fulfill every single condition as that was not the intention of s 10(1). It therefore follows that a trademark which does not satisfy 10(1)(a) does not necessarily imply that the trademark is not registrable. A trademark may still be registrable if it fulfills any one of the above conditions under s 10(1).
>
> This position was accepted *In the Matter of Application of the Eastman Photographic Materials Company Ld for a Trade Mark* [1898] RPC 476 where Lord Herschell in the House of Lords held at p 484 that 'the words that introduce the section, the particulars designated under the headings (a) to (e) are treated as separate and distinct'. The House of Lords here were interpreting a provision of the then UK Act, which dealt with registrability of trademarks. The provision was similar to that found under the Malaysian Trade Marks Act 1976 and starts of with the phrase 'Mark must consist at least one of the particulars ...' and thus would be equally relevant and applicable for the purposes of interpretation of our s 10(1). This would be coupled with the obvious literal and purposive interpretation of s 10(1).

[24] In a nutshell, a trademark is registrable so long as the mark satisfies any of the limbs set out in s 10 of the TMA.

[25] Traditionally, it has long been held in *Re Powell's Trade Mark* [1893] 2 Ch 388 by Bowen LJ as follows:

> The function of a trademark is to give an indication to the purchaser or possible purchaser as to the manufacture or quality of the goods — as to give an indication to the eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market.

[26] The defendant has submitted that the defendant's mark is an invented and fanciful word and therefore registrable pursuant to s 10(1)(c) of the TMA. There is no doubt that the defendant has used it in the course of its trade in tobacco products. In the *Concise Oxford English Dictionary* (11th Ed Revised), 'word' has been widely defined and may also mean a slogan or signal. For purposes of s 3 of the TMA, it has been long held in by Lindley LJ in *In Re Van Duzer's Trade-Mark In Re Leaf, Sons, & Co's Trade-Mark* (1887) 34 Ch D 623; (1887) 56 LJ Ch 377 as follows:

> I think a word to be a 'fancy word' must be obviously meaningless as applied to the article in question. I think it must be a word fanciful in its application to the article to which it is applied in the sense of being so obviously and notoriously inappropriate as neither to be deceptive nor descriptive nor calculated to suggest deception or description. Further than that, I think that the word must have an innate and inherent character of fancifulness which must not depend on evidence, and cannot be supported by evidence, to show, that in fact, it is neither deceptive nor descriptive, nor calculated to be deceptive or descriptive. What I mean is that a fancy word, in my opinion, must speak for itself; it must be a fancy word of its own inherent strength.

The defendant's mark has been registered by MyIPO as a 'stylish verbal' mark which meant words written in style. By the manner it is written, it is to me not wholly pronounceable but certainly fanciful. The discernable pronounceable words are only 'Ori' or 'Orig' and 'nal' which are in themselves meaningless. They are sandwiched by an inverted E alphabet. Put and read together, they are objectively not pronounceable and meaningless too. It is nonetheless plain that prominence has been given to the word 'Ori' by the adopted size of the word itself as well as in its configuration within the defendant's mark as a whole.

[27] The plaintiffs however counter submitted that the word 'Ori' is an abbreviation of the word 'original' as commonly used by the Malay community. There is however no cogent expert evidence adduced before me that it has been indeed so utilised. In the online *Oxford English Dictionary*, the accepted abbreviation of the word 'original' is 'orig'. I have also independently researched the meaning of the acronym 'ORI' in *The Free Dictionary* and my research revealed the following:

ORI	Operational Readiness Inspection
ORI	Orientation
ORI	Office of Research Integrity *(HHS)*
ORI	Old Republic International Corporation *(stock symbol)*
ORI	Origin of Replication
ORI	Oficina de Relaciones Internacionales
ORI	Oriental Research Institute *(India)*
ORI	or Immediate
ORI	Open Source Research Institute
ORI	Operational Risk Index
ORI	Oregon Research Institute
ORI	Orthopaedic Research Institute *(Wichita, KS)*
ORI	Ocean Research Institute
ORI	Oncology Research Institute *(various locations)*

ORI	Originating Agency Identifier *(nine-digit code used by agencies on the law enforcement network)*
ORI	Orthorectified Radar Image
ORI	Octane Requirement Increase
ORI	Open Rivers Initiative *(National Oceanic and Atmospheric Administration)*
ORI	Online Retrieval Interface
ORI	Oxford Research International
ORI	Office of Research and Inventions *(US Navy)*
ORI	Official Records Index *(Florida)*
ORI	Open Ranks Inspection
ORI	Orbital Replacement Instrument
ORI	Open on Rise of Inlet *(pressure valve)*
ORI	Operator-Robot Interaction
ORI	Obesity Research Institute, LLC
ORI	Outdoor Restrooms Incorporated *(Missouri)*
ORI	Overhaul/Repair Instruction

'ORI' is therefore neither related nor connected with the word 'original'. It follows that the defendant's mark could not therefore be construed as a representation of the quality of the defendant's tobacco being original and hence not blended or fake whether pertaining to its flavour, aroma, etc as so alleged by the plaintiffs.

[28] In the premises, I find and hold that the defendant's mark is an invented and fanciful word. In so finding, I am mindful that the plaintiffs have sedulously referred to me the English cases of *Re, Ripley & Son's Trade Mark* (1898) 15 RPC 151 on the mis-spelt word 'Pearl', *Brock (H N) & Co's Application, Orlwoola, Re sub nom Re Trade Marks Act 1905* (1909) 26 RPC 68 on the mis-spelt word 'All Wool', *Electrix Ltd's Application for Trade Marks* [1959] RPC 283 on the word 'electrix' and *'Soflens' Trade Mark* [1976] RPC 694 on the word 'soflens' relating to soft lenses which were all held as non invented words. However, I find that they are all distinguishable on their peculiar facts. Likewise locally, the facts in *Titan (M) Sdn Bhd v The Registrar of Trade Marks* [2009] 7 CLJ 338 on the word 'SURE-LOC' as well as the Court of Appeal case of *Bata Ltd v Sim Ah Ba* on the word 'Power' are distinguishable too. On the other hand, it was held in *Illinois Tool Works, Inc v Pendaftar Cap Dagangan (M)* [2009] 9 MLJ 101; [2010] 3 CLJ 837 that the word 'HIGH TEMP RED' is an invented word. Ultimately, it can on final analysis only be surmised that every case is dependent upon an objective construction of the trademark based on its own peculiar facts.

[29] My finding that the defendant's mark is an invented and fanciful word

is sufficient per se to dismiss the OS but I will also delve into whether it is distinctive in law for completeness.

[30] In this respect, Azahar Mohamed J (now FCJ) held as follows in *Lockhead Martin Corp v Raytheon Co* which are relied by both the parties:

> [37] In summary, for a trademark to be 'capable of distinguishing', it must be inherently distinctive; or factually distinctive. In *Yong Sze Fan & Anor v Sharifah bt Mohd Tamin & Ors* [2008] 7 MLJ 803, Ramly Ali J (as he then was) held at p 817:
>
> > The court is of the view that the mark is distinctive within the meaning of the Trade Marks Act 1976 in that it is capable of distinguishing the goods of the respondents from the goods of other traders. The mark is both inherently and factually distinctive of the respondents in this case. In deciding inherent distinctiveness, the case of *W & G Du Cros Ltd's Application* (1913) 30 RPC 660 can be relied upon. It was held by Lord Parker at p 671 as follows:
> >
> > > The applicant for registration in effect says 'I intend to use this mark as a trademark ie, for the purpose of distinguishing my goods from the goods of other persons', and the registrar or the court has to determine, before the mark is admitted to registration, whether it is such a kind that the applicant, quite apart from the effects of registration, is likely to attain the object he has in view. The applicant's chance of success in this respect, must, I think largely depend upon whether other traders are likely, in the ordinary course of their business and without improper motive, to desire to use the same mark, or some mark closely resembling it, upon or in connection with their own goods.

[31] Based on the available evidence adduced before me, I am satisfied that the defendant has at all material times intended to use the defendant's mark in good faith to distinguish its tobacco products from those marketed by other traders and potentially these other traders are unlikely without improper motive to utilise a similar mark. From my examination of the defendant's Mark, I also find it is by its unique features capable of distinguishing the tobacco marketed by the defendant versus that of other traders. Simply put, I find and hold that the defendant's mark is innate; hence an inherently distinctive mark in law and this is also per se sufficient to dismiss the OS. In this regard, I am nonetheless mindful that Farwell LJ held as follows in the English case of *Joseph Crosfield & Sons Ltd, Re (Perfection Trade Mark)* (1909) 26 RPC 837:

> The object of Trade Mark Law is to protect honest trading; to restrain a man from passing off another's goods as his own, but in exercising that jurisdiction, as in construing the Trade Mark Act, the Court is careful not to interfere with other persons' rights further than necessary for the protection of the claimant and not to allow the claimant to obtain a monopoly further than is consistent with reason and fair dealing. It is necessary, therefore in construing Acts of Parliament so as to read

A them as not to hamper fair trading.

I am in the circumstances here satisfied that there has been no undue trade monopoly enjoyed by the defendant in registering the defendant's mark.

B

[32] In the circumstances, I therefore find that the plaintiffs have not satisfactorily convinced me that the defendant's Mark is non registrable pursuant to ss 10 and/or 14(1)(b)–(1)(g) of the TMA. For the avoidance doubt in light of the ongoing Alor Setar proceedings, I have only of confined my findings here to the registrability of the defendant's mark but made no findings on other related issues in dispute between the parties including whether the defendant's mark would cause confusion or deception when compared to the plaintiffs' mark or the trademark of other traders pursuant to s 14(1)(a) of the TMA.

C

D CONCLUSION

[33] For the foregoing reasons, I hence dismiss the OS with costs of RM25,000 subject and 4% allocator.

E

Application dismissed with RM25,000 cost subject to 4% allocator.

Reported by Izzat Fauzan

F

G

H

I